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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,405	02/27/2004	Adrian Buckley	1578.124 (11636-US-PAT)	5236
54120 7590 07/05/2007 RESEARCH IN MOTION, LTD 102 DECKER CT. SUITE 180 IRVING, TX 75062				
EXAMINER BHATTACHARYA, SAM				
ART UNIT PAPER NUMBER 2617				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/789,405

Applicant(s)

BUCKLEY ET AL.

Examiner

Sam Bhattacharya

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 21-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restriction/Election

1. Newly submitted claims 21-40 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 1-20, drawn to communication based on system selection, are classified in class 455, subclass 552.1.
- II. Claims 21-40, drawn to communication based on roaming lists, are classified in class 455, subclass 432.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, Invention I is used where a mobile communicates in different types of systems in a static environment, and Invention II is used where the mobile moving through different cells in a dynamic environment.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

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on the merits. Accordingly, claims 21-40 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges et al. (US 2003/0186695) in view of Sheymov et al. (US 2002/0023227).

Regarding claims 1 and 15, Bridges discloses that in a radio communication system having a mobile node 68 operable at least to communicate packet data pursuant to a packet communication session by way of a selected network portion of a network part of the radio communication system, the network part having a plurality of network portions, the apparatus for facilitating selection of which of the plurality of network portions forms the selected network portion by way of which the packet data is communicated pursuant to the communication session, the apparatus including a storage element 67 embodied at the mobile node (see paragraph 53, lines 1-15), the storage element selectably containing a listing of a preferred set of network portions associated with the mobile node together with network-portion capabilities of individual ones of the network portions, if any, forming the preferred set; a selector 54 coupled to the storage element, the selector for selecting the selected network portion by way of which the packet data is communicated, selection made by the selector of one of the network portions,

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if any, identified in the listing contained at the storage element that exhibits network-portion capabilities of packet data connectivity, and if none of the network portions, if any, identified in the listing exhibit packet data connectivity, selection made by the selector selectably is made of an other network portion not identified in the listing to exhibit packet data connectivity to form the selected network portion by way of which the packet data is communicated. See FIG. 2A and col. 54, lines 1-17.

Bridges fails to disclose that the network portion capabilities are updateable responsive to access attempts made by the mobile node to access the network portions.

However, in an analogous art, Sheymov discloses a system for network protection in which the network portion capabilities are updateable responsive to access attempts made by the mobile node to access the network portions. See paragraph 12, lines 1-15. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system in Bridges by incorporating this feature taught in Sheymov for the purpose of ensuring that sensitive portions of the network are only access by authorized subscribers.

Regarding claims 2 and 16, Bridges discloses that the plurality of network portions includes a home network associated with the mobile node, the home network maintaining a preferred roaming list identifying preferred network portions by way of which the mobile node is to communicate when roaming beyond the home network, and wherein the listing of the preferred set contained at the storage element includes the preferred roaming list. See paragraph 57, lines 1-16.

Regarding claim 3, Bridges discloses that each network portion of the plurality of network portions is identified by a network identifier and wherein the listing contained at the

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storage element identifies each network portion of the preferred set by the network identifier associated therewith. See paragraph 70, lines 1-15 and paragraph 71, lines 1-14.

Regarding claim 4, Bridges discloses that the network identifier identifying each of the network portions of the preferred set stored at the storage element includes a country code and a network code, the country code identifying a country in which the network portion identified therefrom is located and the network code uniquely associated with the network portion identified therefrom. See paragraph 81, lines 1-25.

Regarding claim 5, Bridges discloses that the network part of the radio communication system is coupled to the mobile node by way of a radio are interfaced and wherein the listing contained at the storage element is formed of information downloaded thereto by way of the radio air interface. See FIG. 2A.

Regarding claims 6 and 17, Bridges discloses that the listing contained at the storage element is updateable. See paragraph 55, lines 1-15.

Regarding claim 7, Bridges discloses that the network-portion capabilities of the individual ones of the network portions include identification of whether the individual ones of the network portions are within communication range of the mobile node to be available thereto by way of which to communicate, availability of the network portions updateable. See paragraph 55, lines 1-15.

Regarding claim 8, Bridges discloses that the network-portion capabilities of the individual ones of the network portions include identification of whether the individual ones of the network portions provide voice data connectivity and of whether the individual ones of the network portions provide the packet data connectivity. See paragraph 56, lines 1-12.

Regarding claim 9, Bridges discloses that the network portions of the plurality of network portions each broadcast signals containing identification information and wherein the apparatus further includes a detector for detecting the signals containing the identification information. See paragraph 64, lines 1-25.

Regarding claim 10, Bridges discloses that selection made by the selector selectably of the another network portion is of a network portion of which the signals containing the identification information is detected by the detector. See paragraph 61, lines 1-25.

Regarding claim 11, Bridges discloses that the detector detects signals containing the identification information broadcast by a first of the network portions and signals containing the identification information by at least a second of the network portions and wherein selection made by the selector selectably of the another network portion is one of the first and at least second network portions, respectively. See paragraph 62, lines 1-20.

Regarding claim 12, Bridges discloses a packet-connection attemptor adapted to receive indications of selection made by the selector, the packet-connection attemptor for attempting to form a packet-connection with the selected network portion. See paragraph 59, lines 1-13.

Regarding claim 13, Bridges discloses that the packet data communicated pursuant to the packet communication session is communicated to effectuate a packet data communication service with an entity identified by an access point name, and wherein the packet-connection attemptor attempts to form the packet connection with the entity identified by the access point name. See paragraph 60, lines 1-18.

Regarding claim 14, Bridges discloses that the listing contained at the storage element further indexes the access point name together with the network portion through which the

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packet data is communicated of the packet-connection attemptor successfully forms the packet connection with the entity. See paragraph 91, lines 1-25.

Regarding claim 18, Bridges discloses that the operations of broadcasting signals from at least selected ones of the network portions and detecting, at the mobile node, the signals broadcast during the operation of broadcasting. See paragraph 56, lines 1-12.

Regarding claim 19, Bridges discloses that the selection made during the operation of selectably selecting of the another network portion is of a network portion of which the signals broadcast during the operation of broadcasting and detected during the operation of detecting. See paragraph 57, lines 1-16.

Regarding claim 20, Bridges discloses that the operation of attempting to form a packet connection with the selected network portion. See paragraph 61, lines 1-25.

Response to Arguments

6. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Bhattacharya whose telephone number is (571) 272-7917. The examiner can normally be reached on Weekdays, 9-6, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sb


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